

EC

Office Action Summary	Application No. 10/021,901	Applicant(s) NORDNESS ET AL.	
	Examiner Robert H Muromoto, Jr.	Art Unit 3765	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 December 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-48 is/are pending in the application.
- 4a) Of the above claim(s) 23-48 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>5-7</u> . | 6) <input type="checkbox"/> Other: |

DETAILED ACTION

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-22, drawn to a disposable garment free of absorbent material, classified in class 2, subclass 67.
- II. Claims 23-48, drawn to an absorbent garment, classified in class 604, subclass 385.13.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are distinct because Group I requires a garment free of absorbent material while Group II is an absorbent garment.

Because these inventions are distinct for the reasons given above and the search required for Group II is not required for Group I, restriction for examination purposes as indicated is proper.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

During a telephone conversation with Maxwell Peterson on July 18, 2003 a provisional election was made without traverse to prosecute the invention of Group I, claims 1-22. Affirmation of this election must be made by applicant in replying to this

Office action. Claims 23-48 have been withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites "a liquid-permeable non-woven material" and then goes on to recite "the garment being substantially free of absorbent and substantially free of liquid impermeable material". This is very confusing as claims 4, 5, and 7 recite that the liquid permeable material be "polypropylene", "polyethylene" or "nylon", respectively. All three of these have, however small, a degree of absorptive properties. It is not clear how the invention can contain liquid permeable material as well as be free of absorbent material.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claims 1-11, and 17-22, to the extent that they are understood by the Examiner, are rejected under 35 U.S.C. 102(a) as being anticipated by Cristoffel et al.

Cristoffel discloses a one-piece, disposable swimsuit in many different embodiments. The outer material of the suit or coverstock 50 can take many form as and materials and can be elastic or inelastic, stretchable or unstretchable (col. 11, line 1). The stretchable material may include woven (mesh); (claim 2) or nonwoven (claim 3) material (col. 11, line 47-49). The coverstock 50 of the suit can be a single layer of material or a multi-layered (claim 8) laminate structure. For instance, the coverstock 50 can include a liquid permeable outer layer and a liquid permeable inner layer that are suitably joined together by a laminate adhesive (col. 11, lines 51-55). The liquid permeable outer layer can be any suitable material and desirably one that provides a generally cloth-like texture. One example of such a material is a spunbond polypropylene (claim 4) nonwoven web having a basis weight (claims 9-11) of about 1-100 grams per square meter (col. 12, lines 1-4). Other examples of suitable materials include polyolefin (polyethylene) or other thermoplastic (nylon) nonwoven webs having basis weights in the same ranges, including spunbond webs, meltblown webs, and spunbond/meltblown/spunbond webs (col. 12, lines 7-12); (claims 5-7).

Concerning the fastening means of the garment, the bodice 42 is attached to the chassis 22 about the waist region 24 (col. 5, lines 40-42). Leg elastics 56 can be attached to the chassis 22 about the leg openings 26 (claims 1 and 18-20) for enhanced fit and containment of waste (col. 5, lines 60-65). The coverstock 50 can have areas of differential stretch to improve fit. For example, desirable areas of greater stretch include the waist region 24. An embodiment shown in fig. 10 shows strips of elastic material 112 added around the waist (claim 17) to improve fit (col. 7, lines 29-35).

In still another embodiment of the swimsuit 20 shown in figure 18, the swimsuit can be made of primarily one piece of coverstock 50 with a neck opening 48 and two leg openings 26 cut within the coverstock 50. A refastenable fastening system 92, can be applied to the front region 44 of bodice 42 along the waist region 24, such that the bodice 42 and the chassis 22 can be releasably engaged to each other (col. 8, lines 20-32); (claims 21 and 22).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 12-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cristoffel et al.

Although Cristoffel teaches essentially all of the limitations of the instant invention Cristoffel does not teach the specific pore size or tensile strength of the mesh material.

However, with respect to the limitations of pore size and tensile strength, the specification contains no disclosure of either the critical nature of the claimed limitations nor any unexpected results arising therefrom, and that as such the limitations were arbitrary and therefore obvious. Such unsupported limitations cannot be a basis for patentability, since where patentability is said to be based upon particular dimensions or another variable in the claim, the applicant must show that the chosen variables are critical. *In re Woodruff*, 919 F.2d 1575, 1578, 16 USPQ2d 1934 (Fed. Cir. 1990). One having ordinary skill in the art would be able to determine through routine experimentation the ideal levels of pore size and tensile strength for a particular application.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Numerous references of disposable garments including nonwoven materials have been cited.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert H Muromoto, Jr. whose telephone number is 703-306-5503. The examiner can normally be reached on 8-530, M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Calvert can be reached on 703-305-1025. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9302 for regular communications and 703-872-9303 for After Final communications.

Art Unit: 3765

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0861.

bhm
July 22, 2003



JOHN P. CALVERT
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3700